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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,656	11/21/2003	Alfonso O. Lopez	014208.1637 (93-03-022)	2376
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE, 6TH FLOOR DALLAS, TX 75201-2980			EXAMINER STRODER, CARRIE A	
			ART UNIT 3689	PAPER NUMBER
			NOTIFICATION DATE 04/03/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/719,656	<b>Applicant(s)</b> LOPEZ ET AL.	
	<b>Examiner</b> CARRIE A. STRODER	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. This is in response to the applicant's communication filed on 21 November 2003, wherein:

Claims 1-14 are currently pending; and

Claims 15-19 are non-elected.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, drawn to an apparatus and the corresponding method for harvesting a business solution, classified in class 705, subclass 001.

II. Claims 15-17, drawn to an unknown statutory class for a reference solution architecture based on a model, classified in class 705, subclass 010.

III. Claim 18-19, drawn to a method for creating a business solution from a reference solution architecture model, classified in class 705, subclass 007.

3. Inventions I, II, and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions, as shown in the claims listed have different steps/modes of operations and thus

Art Unit: 3689

producing different effects, even though they may have one common step.

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

5. **Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined**, either Group I or II or III, even though the

Art Unit: 3689

requirement may be traversed (37 CFR 1.143) **and (ii)**

**identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

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If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is

Art Unit: 3689

the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with **David Wille on 05 March 2009**, a provisional election was made with traverse to **prosecute the invention of 10/719656, claims 1-14**. Affirmation of this election must be made by applicant in replying to this Office action. **Claims 15-29 are withdrawn** from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected inventions.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-14 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states "creating a logical technology architecture," which is vague and indefinite. It is unclear whether this is referring to a machine, such as a computer, or

Art Unit: 3689

to a design. Examiner assumes applicant is referring to a machine.

Claim 3 states "wherein the logical technology architecture, the solution type, the plurality of standards, the workable solution and the plurality of technology products encompass a reference solution architecture," which is vague and indefinite. Further, it does not recite a positive step, but only seems to be a definition. Further examination is precluded.

Claim 8 refers to "memory," which is vague and indefinite. This memory could be the memory of a human being or of a machine. Further, if it is a machine, memory refers to storage only, and is not "operable to" accomplish the recited steps.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-14 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) involve a particular machine, or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184

Art Unit: 3689

(1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978);  
*Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of  
these requirements is met by the claim, the method is not a  
patent eligible process under §101 and is non-statutory subject  
matter. With respect to claims 1-14, the claim language does  
not include the required tie or transformation and thus is  
directed to nonstatutory subject matter.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs  
of 35 U.S.C. 102 that form the basis for the rejections under  
this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or  
a foreign country or in public use or on sale in this country, more than one  
year prior to the date of application for patent in the United States.

4. **Claims 1-2 and 4-14 are rejected** under 35 U.S.C. 102(b) as  
being anticipated by Ruffin et al. (US 6249769).

**Referring to claim 1:**

Ruffin teaches

receiving a business solution (col. 6, lines 6-20; "the  
representative will engage a potential customer or customers...and  
describe the preferred solution");



creating a logical technology architecture used to implement the business solution (col. 6, lines 6-20; "the provider will have a particular product...");

categorizing the business solution into a solution type (col. 6, lines 6-20; "attempt to discern an appropriate customer set" inherently requires categorizing the solution); and

mapping a plurality of standards used by the business solution (col. 6, lines 6-20; "it is...determined whether the proffered solution matches the customers' IT requirements").

**Referring to claim 2:**

Claim 2 is dependent upon claim 1; therefore, the rejection of claim 1 is incorporated as if fully recited herein.

Ruffin teaches

adding a workable solution based on the business solution (col. 6, lines 6-20; "the provider and customer engage in an ad-hoc series of planning and implementation steps"); and

mapping a plurality of technology products used in the workable solution (col. 6, lines 6-20; "it is...determined whether the proffered solution matches the customers' IT requirements").

**Referring to claim 4:**

Claim 4 is dependent upon claim 1; therefore, the rejection of claim 1 is incorporated as if fully recited herein.

Ruffin teaches wherein creating a logical architecture used to implement a reference solution comprises generalizing a plurality of technology products used to implement the business solution (col. 6, lines 6-20; "describe the proffered solution").

**Referring to claim 5:**

Claim 5 is dependent upon claim 1; therefore, the rejection of claim 1 is incorporated as if fully recited herein.

Ruffin teaches wherein categorizing the business solution into a type comprises categorizing the business solution according to an industry in which the business solution has been applied (col. 9, lines 8-19; "proceeds to select target customers aligned with the various organized solutions offerings...the determination of whether a particular customer aligns with a proffered solution may be based upon the type of industry in which the customer does business").

**Referring to claim 6:**

Claim 6 is dependent upon claim 1; therefore, the rejection of claim 1 is incorporated as if fully recited herein.

Ruffin teaches wherein categorizing the business solution into a type comprises categorizing the business solution according to a business domain in which 5 the business solution

Art Unit: 3689

has been applied (col. 9, lines 8-19; wherein "type of industry" is interpreted as "business domain").

**Referring to claim 7:**

Claim 7 is dependent upon claim 1; therefore, the rejection of claim 1 is incorporated as if fully recited herein.

Ruffin teaches wherein the plurality of standards used by the business solution comprise at least one of industry standards, industry application framework, application architecture design principle, design patterns and application programming interface (col. 6, lines 6-20 "customers' IT requirements" and col. 13, line 36 thru col. 14, line 27 "operating system software").

**Referring to claim 8:**

Ruffin teaches

a memory comprising a reference solution architect operable to (col. 8, lines 9-35):

receive a business solution (col. 6, lines 6-20; "the representative will engage a potential customer or customers...and describe the preferred solution");

create a logical technology architecture used to implement the business solution (col. 6, lines 6-20; "the provider will have a particular product...");

categorize the business solution into a solution type (col. 6, lines 6-20; "attempt to discern an appropriate customer set" inherently requires categorizing the solution); and

map a plurality of standards used by the business solution (col. 6, lines 6-20; "it is...determined whether the proffered solution matches the customers' IT requirements").

**Referring to claims 9 and 11-14:**

Claims 9 and 11-14 are dependent upon claim 8; therefore, the rejection of claim 8 is incorporated as if fully recited herein.

Claims 9 and 11-14 are the system claims associated with the method of claims 2 and 4-7, respectively; therefore, they are rejected on the same basis as claims 2 and 4-7.

**Referring to claim 10:**

Claim 10 is dependent upon claim 8; therefore, the rejection of claim 8 is incorporated as if fully recited herein.

Ruffin teaches further comprising a database operable to store the logical technology architecture, the solution type, the plurality of standards, the workable solution and the plurality of technology products as a reference solution architecture (col. 7, lines 59-65).

Furthermore, storing the logical technology architecture, the solution type, the plurality of standards, the workable

Art Unit: 3689

solution and the plurality of technology products as a reference solution architecture in a database are non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable

Art Unit: 3689

weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the act of storing the logical technology architecture, the solution type, the plurality of standards, the workable solution and the plurality of technology products as a reference solution architecture, can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Adams et al. (US 20030040920).

**Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/719,656  
Art Unit: 3689

Page 15

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Examiner, Art Unit 3689

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3/12/09